

REMARKS

Claims 26-29 and 31-53 are pending in this application. Claims 26, 31, 51, 52 and 53 are independent claims. Claims 27-29 are withdrawn. Claims 1-25 and 30 have been canceled. Claims 32-41 and 43 were previously presented. Claims 45-53 are new. Claims 26, 31, 42 and 44 are currently amended. Applicant believes all payments have been submitted; however, if payment is deficient please debit the Deposit Account 50-1660.

Failure to Address All Claims

The Office has failed to substantively address, on the merits, claims 31 and 41-44. As such, Applicant believes the Finality of the Office Action is premature. MPEP §§ 706.07(a), (c). Applicant respectfully requests the Office enter these arguments and amendments, withdraw the Finality of the current Office Action, and issue a new complete Office Action, on the merits, that addresses all current claims in the patent application. MPEP § 706.07(d).

In the event the Office meant to indicate claims 31 and 41-44 contain allowable subject matter, Applicant has rewritten claim 31 in independent form and has amended claims 42 and 44 to depend therefrom.

35 U.S.C § 101 Rejection

Claim 26 and 38-40

The Office has rejected claims 26 and 38-40 as being directed to non-statutory subject matter under 35 U.S.C. § 101. Amended claim 26 requires "a dose having at

least 10^9 cfu of an isolated bacterium of the genus *Dietzia*". Applicant has made the above amendment to expedite prosecution of the application and believes "an isolated bacterium" does not read on a product of nature. Applicant respectfully requests the Office withdraw the rejections of claims 26 and 38-40.

35 U.S.C § 102(b) Rejection of Claims 26 and 38-40 – Nishimaki et al.

Claims 26 and 38-40 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Nishimaki et al. (5,989,892), as evidenced by Rainey et al. While Applicant does not necessarily agree with the rejection, in order to expedite prosecution, Applicant has amended claim 26 to require "A composition, comprising a dose having at least 10^9 cfu of an isolated bacterium of the genus *Dietzia*, an active fragment thereof, a protein secreted therefrom, or combinations thereof, such that the dose is capable of reducing or preventing the symptoms of a disease or syndrome whose causative agent is a mycobacterium". Nishimaki et al., as evidenced by Rainey et al., fails to disclose or teach the claimed composition. Thus, Nishimaki et al., as evidenced by Rainey et al., cannot anticipate claim 26 or the claims that depend therefrom (claims 38-40). MPEP § 2131. Applicant respectfully requests the Office withdraw the rejections of claims 26 and 38-40.

The Office uses Rainey et al. for the purpose of indicating the *Rhodococcus maris* in Nishimaki et al. was renamed *Dietzia maris*. Applicant agrees that Rainey et al. teaches that *Rhodococcus maris* was renamed *Dietzia maris*; however, such renaming took place at least as early as the publication date of Rainey et al. – January 1995. The Nishimaki et al. reference was filed on June 13, 1996. As a result of Nishimaki et al.

being filed subsequent to the publication of the revelation in Rainey et al., the *Rhodococcus maris* discussed in Nishimaki et al. cannot be the *Rhodococcus maris* of Rainey et al., as it would then be referred to by the term *Dietzia maris*. That is, there is no evidence in the record that, as of June 13, 1995, one skilled in the art interchangeably referred to *Dietzia maris* as *Rhodococcus maris*. Applicant respectfully asserts Rainey et al. fails to purport the proposition for which it is cited.

35 U.S.C § 102(b) Rejection of Claims 26 and 38-40 – Duckworth et al.

Claims 26 and 38-40 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Duckworth et al. While Applicant does not necessarily agree with the rejection, in order to expedite prosecution, Applicant has amended claim 26 as noted above. Duckworth et al. fails to disclose or teach the claimed composition. Thus, Duckworth et al. cannot anticipate claims 26 or the claims that depend therefrom (claims 38-40). MPEP § 2131. Applicant respectfully requests the Office withdraw the rejections of claims 26 and 38-40.

35 U.S.C § 103(a) Rejection of Claims 26 and 31-40 – Alkemade et al in view of Mosser and Rainey et al.

Claims 26 and 32-40 have been rejected as being unpatentable over Alkemade et al. (6,139,844) in view of Mosser (WO 99/05304) and Rainey et al. While Applicant does not necessarily agree with the rejection, in order to expedite prosecution, and without conceding the propriety of the combination of the cited references, Applicant has amended claim 26 as noted above. The references of Alkemade et al., Mosser and

Rainey et al., individually or in combination, do not teach, disclose, suggest or render obvious the features of claim 26; particularly the structural features requiring 10^9 cfu of an isolated bacterium of the genus *Dietzia*, an active fragment thereof, or a protein secreted therefrom. Therefore, Applicant asserts the references, individually or in combination, fail to render obvious amended claim 26 and the claims depending therefrom (claim 32-40). Applicant respectfully requests the Office withdraw the rejections of claims 26 and 32-40.

CONCLUSION

Applicant does not waive any substantive arguments Applicant may not have addressed concerning the propriety of the asserted claim rejections and reserves those arguments for future responses. Applicant respectfully submits that the application is in condition for review and allowance.

Applicant's undersigned attorney may be reached by telephone at (715) 835-5232 or by facsimile at (715) 835-9890. All correspondence should be directed to the below listed address.

Respectfully Submitted,

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